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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/069,460 | 06/11/2002 | Francis Pruche | 2365-35 | 3379 |

7590 07/28/2003

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EXAMINER

LAMM, MARINA

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 07/28/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-------------------------|------------------|
| Office Action Summary | Application N . | Applicant(s) |
| | 10/069,460 | PRUCHE ET AL. |
| | Examiner Marina Lamm | Art Unit 1616 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
 5) Claim(s) ____ is/are allowed.
 6) Claim(s) 1-11 is/are rejected.
 7) Claim(s) ____ is/are objected to.
 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 11 June 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: ____ . |

DETAILED ACTION

Claims 1-11 are pending in this application filed 6/11/02.

Specification

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) **TITLE OF THE INVENTION.**
- (b) **CROSS-REFERENCE TO RELATED APPLICATIONS.**
- (c) **STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.**
- (d) **INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC** (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) **BACKGROUND OF THE INVENTION.**
 - (1) **Field of the Invention.**
 - (2) **Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.**
- (f) **BRIEF SUMMARY OF THE INVENTION.**
- (g) **BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).**
- (h) **DETAILED DESCRIPTION OF THE INVENTION.**
- (i) **CLAIM OR CLAIMS** (commencing on a separate sheet).
- (j) **ABSTRACT OF THE DISCLOSURE** (commencing on a separate sheet).
- (k) **SEQUENCE LISTING** (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Objections

2. Claim 6 is objected to because of the following informalities: the claim recites the limitation "in any claim 1". It appears that this is a typographical error caused by deleting multiple dependencies in the claims. Claim 6 is being interpreted as depending from Claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad

recitation “process fro treating”, and the claim also recites “especially for caring for, making up or coloring”, which is the narrower statement of the range/limitation.

6. Claim 4 recites the limitation " process as claimed in claim 1, in which at least one jet" in line 1. There is insufficient antecedent basis for this limitation in the claim because Claim 1 does not recite “jet”. It appears that Claim 4 should depend from Claim 2 rather than Claim 1.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Suares et al. (US 5,612,044).

Suarez et al. teach a method for imparting a tan to the human skin, said method comprising dispensing equal amounts of DHA composition and amino acid composition from their respective compartments of the multi-compartment container onto the human skin, mixing the phases together and rubbing the resulting mixture into skin. See Abstract; col. 8, lines 31-36. Both compositions contain over 10 wt% of at least one solvent such as water. See col. 8, Example 2. With respect to the limitation “by applying at least two treatment products ...to a localized area...as a function of characteristics of the localized area and/or of a predetermined design”, it is being interpreted as follows: either the ingredients of the treatment products, or amounts of the ingredients, or amount of the treatment product or a pattern of application depend on the characteristics of the localized area of the body and/or on a predetermined

design. The method of Suares et al. utilizes ingredients that impart tan of a natural hue and are safe to use on the human skin. See col. 2, lines 6-13.

Thus, Suares et al. teach each and every limitation of Claim 1.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al. (US 6,341,831).

Weber et al. teach skin decoration apparatus and method of decorating human skin by applying on the skin multicolored designs using ink jet printing technology. See Abstract. Multiple biocompatible inks or dyes are carried from their respective reservoirs and sprayed onto the skin from multiple electronically controlled nozzles, thus allowing a predetermined image or pattern to be placed on any part of the human body. See Abstract; col. 6, lines 32-48; col. 7, lines 1-11; Claims 7, 9. Weber et al. teach using rapid-drying inks in a volatile solvent. See col. 6, line 59. Water-soluble inks may be used for making test decorations which can be evaluated and washed-off. See col. 6, lines 44-46. Weber et al. teach using Wirejet™ technology which has certain advantages over other ink jet technologies. See col. 2, lines 48-56. However, a drawback of the Wirejet™ technology is that it has limited resolution of 500 dpi. See col. 2, lines 56-60. Weber et al. also describes other conventional inkjet technologies

such as thermal technology and piezoelectric technology. See col. 1, line 56 – col. 2, line 35. The advantages of the thermal technology include enhanced resolution up to 1200 dpi. See col. 2, lines 12-15. The advantages of piezo method include better control over the shape and size of ink droplet release and enhanced resolution up to 1600 dpi. See col. 2, lines 25-37. With respect to Claims 3 and 4, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Weber et al. such that to use either thermal or piezo method. One having ordinary skill in the art would have been motivated to do this to obtain enhanced resolution as suggested by Weber et al. above. The reference does not explicitly teach the claimed concentration of at least one solvent. However, the determination of optimal or workable concentration of the solvent by routine experimentation is obvious absent showing of criticality of the claimed concentration. One having ordinary skill in the art would have been motivated to do this to obtain the desired intensity of the ink and/or rheology of the ink composition.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,268,166 – discloses depositing cosmetic materials onto the skin by electrostatic spraying; US 6,035,860 and 6,336,694 – disclose systems and methods for applying artwork to fingernails; US 6,067,996 and 6,286,517 – disclose nail decoration using ink jets.

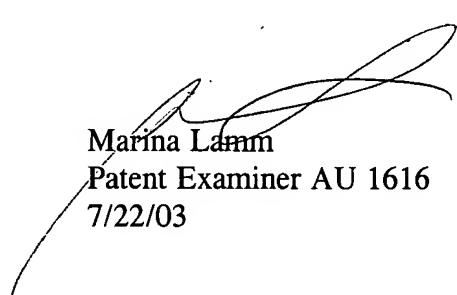
12. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (703) 308-2927.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Marina Lamm
Patent Examiner AU 1616
7/22/03